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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,069	02/04/2000	Ted Eugene Wright	77017.002	9708

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ROBERT BERGSTROM  
BLACK LOWE & GRAHAM PLLC  
816 SECOND AVENUE  
SEATTLE, WA 98104

EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/499,069

Applicant(s)

WRIGHT, TED EUGENE

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Declaration***

1. The declaration under 37 CFR 1.132 filed August 05, 2002 is insufficient to overcome the rejection of claims 1-7 and 11-15 based upon Skelton ('611), Cowan ('396), Jacobs et al. ('737) and Zoland ('956) applied under 35 U.S.C. 103 as set forth in the last Office action because: It refer(s) only to the system described in the above referenced application and not to the individual claims of the application. As such the declaration does not show that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

2. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton ('611) in view of Cowan ('396) and further in view of Jacobs et al. ('737).

Skelton discloses a single sheet form (23) (advertising medium for use in promoting hotels, restaurants, and the like (col. 1, lines 6-14)) comprising an unfolded

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form including a number of lines of perforations (44, 46, 48, 50, 52, 54, 56, and 58); the form including pre-printed textual and graphical information (col. 4, lines 53-65); the form being rectangular and having a greater vertical dimension than a horizontal dimension (col. 4, lines 28-35); and a lower tab (43) being separated from a central portion of the form by a horizontal line of perforations (45); wherein a packet is formed by folding the packet about the horizontal line of perforations and then about the vertical line of perforations.

Regarding the form being a key packet, in particular, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the form of Skelton is capable of performing the intended use of being a key packet, as claimed, since Skelton discloses retaining tickets and advertisements, such as coupons, within the container/envelope (see col. 1, lines 58-66).

Regarding the packet including at most two lines of perforations that allow the unfolded packet to be quickly and accurately folded into a complete packet in two or fewer steps, Skelton discloses that the total preferable number of panels is nine, however, "other total numbers of panels from three to eight may be utilized." (col. 4, lines 65-67). Therefore, if three panels (i.e., 24, 26 and 43) were to be used, there

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would be only two lines of perforations for folding the form into a complete packet. The operation would require only two steps of folding (for example, folding panel 43 in an upward direction over panel 26 and then folding panel 24 over panel 26) for completing the packet.

Skelton discloses the claimed invention except for a registration form placed at the top portion of the form and separated from the form by a line of perforations. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an additional flap/panel located at the top portion of the form and separated from the form by a line of perforations, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Furthermore, Cowan discloses a form (12) having a tab portion (form) (22) extending from the top of the form (12) and separated from the form (12) by a line of perforations (54). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a detachable form at the top of the packet, as taught by Cowan, to provide an additional detachable flap for surrendering to someone for registration, ticketing, couponing, etc.

Regarding the form being a registration form, in particular, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the

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intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the form (tab portion) of Skelton, as modified by Cowan, is capable of performing the intended use of being a registration form, as claimed, since it would only require providing registration indicia on the form. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

Skelton, as modified by Cowan, discloses the claimed invention except for one or more die-cut slots in the unfolded packet for retaining a number of keys.

Jacobs et al. disclose a combined key holder and booklet having a die-cut slit (40) that is capable of retaining a hotel key. The booklet is comprised of folded panels joined by a longitudinally extending adhesive strip (17). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a die-cut slit, as taught by Jacobs et al., to provide a retention means for items to be placed in the packet.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton in view of Cowan and Jacobs et al. and further in view of Zoland ('956).

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Skelton, as modified by Cowan and Jacobs et al., discloses the claimed invention except for the key being selected from a group consisting of metal and magnetic key cards.

Zoland discloses a thin leaf suitable for use as a card or key carrying case for holding hotel keys wherein the keys may be an ordinary metallic key or a flat card key with a magnetic stripe or other mechanism for encoding a key (col. 5, lines 9-22). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the packet of Skelton to include a magnetic key card for insertion into the pocket of the packet, as taught by Zoland, to provide an insert into the packet that may be used to obtain entry into a secure room and/or area.

6. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skelton in view of Cowan and Jacobs et al., as used above, and further in view of Pacione ('401<sup>978</sup>).

Skelton, as modified by Cowan and Jacobs et al., discloses that each of the panels may be printed with advertisement materials (i.e. redemption coupons, self addressed postage prepaid cards, printed display symbols, etc. – see col. 4, lines 53-56).

Skelton, as modified by Cowan and Jacobs et al., disclose the claimed invention except for explicitly disclosing that the advertisement materials are printed on the panels by feeding the panels through a commercially available computer printer.

Pacione discloses a two-piece folder kit having a front panel (10) and a rear panel (12) adhesively secured together. The rear panel includes a rectangular portion (22), pocket portion (24) and pocket flap (26). The rear panel being preassembled to form a pocket by folding the pocket flap along scoreline (25) over pocket portion (24) and then pocket portion (24) folded along scoreline (23). Pacione further discloses that the front panel can receive printed material by passing the panel through a conventional photocopier or small-sized offset printer (see col. 3, lines 32-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Skelton's invention to include feeding the sheet through a computer printer, as taught by Pacione, to provide printed advertisement, graphics, company logos, etc. on the sheet for the purpose of advertising a particular company and/or product.

Regarding claim 12, the sheet is made of paper.

Regarding claim 13, the sheet is preprinted with textual and graphical information (see figures 14 and 15 and col. 4, lines 53-56).

Regarding claims 14 and 15, see the above rejections to claim 11.

### ***Response to Arguments***

7. Applicant's arguments filed December 4, 2002 have been fully considered but they are not persuasive.



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1.132 Declaration

Applicant finds perplexing the examiner's stated reasons for finding the declaration insufficient. The examiner refers to a lack of showing that the objective evidence of nonobviousness is commensurate in scope with the claims. Applicant then states that this statement appears to refer to Section 716.02(d) of the MPEP. It is asserted that the examiner did not solely rely upon this section of MPEP 716 for consideration of the declaration. The examiner, instead, directs the applicant's attention to the following sections of MPEP 716:

**716 Affidavits or Declarations Traversing Rejections, 37 CFR 1.132*****37 CFR 1.132. Affidavits or declarations traversing rejections or objections.***

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection are responsive to the rejection and present sufficient facts to overcome the rejection. This rule sets forth the general policy of the Office consistently followed for a long period of time of receiving affidavit evidence traversing rejections or objections. All affidavits or declarations presented which do not fall within or under other specific rules are to be treated or considered as falling under this rule.

¶ 7.66 Affidavit or Declaration Under 37 CFR 1.132: Insufficient

The [ 1 ] under 37 CFR 1.132 filed [ 2 ] is insufficient to overcome the rejection of claim

[ 3 ] based upon [ 4 ] as set forth in the last Office action because:

Examiner Note

1.

In bracket 1, insert either --affidavit-- or --declaration--.

2.

In bracket 2, insert the filing date of the affidavit or declaration.

3.

In bracket 3, insert the claim or claims affected.

4.

In bracket 4, indicate the rejection that has not been overcome, including the statutory

grounds, i.e.: insufficiency of disclosure under 35 U.S.C. 112, first paragraph; lack of

utility and/or inoperativeness under 35 U.S.C. 101; a specific reference applied under 35

U.S.C. 103; etc. See MPEP § 716.

5.

Following this form paragraph, set forth the reasons for the insufficiency; e.g., categories include: --untimely--; --fails to set forth facts--; --facts presented are not

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germane to the rejection at issue--;--showing is not commensurate in scope with the claims--; etc. See MPEP § 716. Also include a detailed explanation of the reasons why the affidavit or declaration is insufficient. Any of form paragraphs 7.66.01 - 7.66.05 may be used, as appropriate.

**¶ 7.66.03 Reason Why Affidavit or Declaration Under 37 CFR 1.132 Is Insufficient: Refers Only to Invention, Not to Claims**

It refers only to the system described in the above referenced application and not to the individual claims of the application. As such the declaration does not show that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

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The declaration is directed to how the invention was reduced to practice and the continued diligence of the invention and not to how the claims are nonobvious over the cited references. The submitted correspondence, purchase orders, sample forms and other materials fail to distinguish the claimed invention from the references upon which the rejections are based. The provided material dates back to the summer of 1998. The references used in the rejections were patented more than one year prior to the filing of the provisional patent application (May 20, 1999). Therefore, the examiner maintains that the declaration is insufficient to overcome the rejections of record.

### 35 U.S.C. 103 (a) Rejections

Applicant argues that Skelton's unfolded form is not rectangular and could not be fed through a laser printer. The examiner disagrees. As seen in the figures, panels 24, 26, 28, 30, 32, 34, 36, 38 and 40 are individually rectangular in shape and when the envelope is complete, the shape continues to be rectangular. Furthermore, it would have been an obvious matter of design choice to make the different portions of the form of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Applicant argues that there is a lack of motivation or suggestion to combine the references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all of the references (Skelton, Cowan, Jacobs et al., Zoland and Pacione) disclose foldable panels of sheet material to form pockets for retaining items. Skelton discloses a foldable envelope having a pocket (formed by flap 43) for retaining tickets and advertising coupons. Cowan discloses a foldable envelope having a plurality of foldable panels providing a pocket for retaining tickets. Jacobs et al. disclose a foldable booklet having a die cut providing a pocket for retaining keys. Zoland discloses a foldable booklet having inner pockets (24) for retaining airline tickets and a pocket (43) for holding a metallic hotel key. Finally, Pacione discloses a foldable folder having an inner pocket for holding items, wherein the folder can be printed upon by a conventional printer. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that Skelton's form is not capable of performing the intended use of securely holding a key. The examiner disagrees. As set forth in the above rejections, Skelton discloses retaining tickets and advertising coupons (as seen in figure 15).

Should the user of Skelton's envelope desire to carry keys in the envelope, the keys would fit behind the flap (43) just as the ticket is secured behind the flap in figure 15.

Note: the arguments with respect to Pacione ('401) are moot in view of the newly cited reference to Pacione ('978) which is well before the filing of the provisional application to which the current application claims priority.

For the reasons as set forth above, the rejections are maintained.

**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose panels that may be printed upon by a printer.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

*Monica S. Carter*  
MONICA CARTER  
PATENT EXAMINER

February 19, 2003